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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,830	06/14/2006	Hitoshi Asahi	52433/851	5012

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EXAMINER	
YEE, DEBORAH	
ART UNIT	PAPER NUMBER
1793	
MAIL DATE	DELIVERY MODE
06/23/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/582,830	ASAHI ET AL.	
	Examiner	Art Unit	
	Deborah Yee	1793	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 June 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/Deborah Yee/
Primary Examiner
Art Unit: 1793

Continuation of 11. does NOT place the application in condition for allowance because:

Claims 1 to 22 are rejected under 35U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,988 to Kurebayashi et al. alone or in view of CA 2,429,439 for the reasons stated in the previous office action dated March 13, 2009.

Applicant submitted that the present invention is directed to steel plate for a line pipe "having a microstructure composed of degenerated upper bainite of more than 70%". That is the degenerated upper bainite microstructure of more than 70% of the present invention is the microstructure of the base steel. In comparison,US-998 teaches a welded steel plate wherein the HAZ microstructure has a bainite microstructure of more than 80%. It is well known that microstructure of the base steel before welding cannot be determined from the microstructure of the welded HAZ structure because of the heat of welding.

In response to argument,US-988 teaches steel plate having a composition with constituents whose wt% ranges overlap those recited by the claims and exhibits similar properties of high strength and low-temperature toughness. In addition, steel is processed in substantially the same manner as claimed by applicant comprising the steps of hot rolling at recrystallization temperature followed by hot rolling at the non-recrystallization temperature with a total cumulative reduction that can be less than 75% followed by cooling at a rate of 1 to 60C/sec to 600C or below. Since composition and process of making are closely met, then bainitic microstructure would be expected at the base of the steel in addition to the HAZ of weldment. Note that it is the process steps of making steel plate that produce the bainite structure and not the welding step. During welding, a large current is passed briefly through the metal to form weldment such that the heat affected zone is modifed but not enough to change its entire microstructure to bainite as suggested by Applicant.

In addition, since Applicant's method claims 15 to 22 do not recite "having a microstructure composed of degenerate upper bainite of more than 70%", then such limitation would not be a patentable consideration for method claims.

Applicant argued that specific examples in table 1 of US-988 do not meet the claimed composition and exhibit tensile strength values ranging from 508 to 605 MPa which are much lower than the claimed tensile strength of 880 to 1080 MPa.

In response to argument, it is the Examiner's position that despite the fact the US-988 does not exemplify any specific example falling within the claimed composition, US-988 still teaches the general steel having constituents whose wt%ranges overlap those recited by the claims; and such overlap establishes a prima facie case of obviousness, In regard to tensile strength, Applicant recites"transverse tensile strength" which would not be a valid comparision with prior art tensile strength since it is uncertain whether prior art tensile strength is measured in transverse or longitudinal direction. Conventionally, the Standard tensile strength testing is measured longitudinally.

For the foregoing reasons, claims do not patentably distinguish over prior art.